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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097707,320	11/07/00	SOBOLOV-JAYNES	S PC10408A

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HM12/1016

EXAMINER

JARVIS, W

ART UNIT	PAPER NUMBER
1614	

DATE MAILED: 10/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/707,320

Applicant(s)

SOBOLOV-JAYNES, SUSAN B.

Examiner

William R. Jarvis

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

*Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 2 and 10, drawn to a pharmaceutical composition and method of treating depression and anxiety with a) an anxiolytic or antidepressant agent and b) a CNS-penetrant NK-1 antagonist, classified in class 514, subclass 305 and other subclasses.
  - II. Claims 3 and 13, drawn to a pharmaceutical composition and method of treating depression and anxiety with a) an anxiolytic or antidepressant agent and b) a CNS-penetrant NK-1 antagonist, classified in class 514, subclass 299 and other subclasses.
  - III. Claims 4 and 11, drawn to a pharmaceutical composition and method of treating depression and anxiety with a) an anxiolytic or antidepressant agent and b) a CNS-penetrant NK-1 antagonist, classified in class 514, subclass 315 and other subclasses.
  - IV. Claims 5 and 14, drawn to a pharmaceutical composition and method of treating depression and anxiety with a) an anxiolytic or antidepressant agent and b) a CNS-penetrant NK-1 antagonist, classified in class 514, subclass 412 and other subclasses.
  - V. Claims 6 and 15, drawn to a pharmaceutical composition and method of treating depression and anxiety with a) an anxiolytic or antidepressant agent and b) a CNS-penetrant NK-1 antagonist, classified in class 514, subclass 278 and other subclasses.

- VI. Claims 7 and 16, drawn to a pharmaceutical composition and method of treating depression and anxiety with a) an anxiolytic or antidepressant agent and b) a CNS-penetrant NK-1 antagonist, classified in class 514, subclass 429 and other subclasses.

Claims 1, 8, 9, and 12 will be examined only as they relate to the elected invention.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-VI differ so widely in the structures of the NK-1 receptor antagonists that examination of the groups in one application would be extremely burdensome to the examiner. Furthermore, a reference disclosing one class of NK-1 antagonists would not anticipate or make obvious another class of NK-1 antagonists. Accordingly, restriction for examination purposes as indicated is proper.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for one group is not required for the remaining groups, restriction for examination purposes as indicated is proper.
5. Claims 1-16 are generic to a plurality of disclosed patentably distinct species comprising various anxiolytic & antidepressant agents and various NK-1 antagonists. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from the elected group (including a compound each from a) and b)), even though this requirement is traversed. It is additionally requested that applicant provide the structure of the elected compound if it is not well-known.

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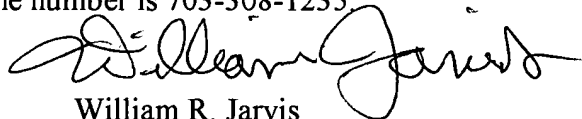
Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William R. Jarvis whose telephone number is 703-308-4613. The examiner can normally be reached on Monday, Tuesday, Thursday & Friday 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne C. Seidel can be reached on 703-308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



William R. Jarvis  
Primary Examiner  
Art Unit 1614

wrj  
October 15, 2001